

Application. № 10/675,458  
Response Dated April 18, 2011  
Reply to Final Office Action of July 22, 2008

### **REMARKS / ARGUMENTS**

Claims 1-38 are pending in the instant application. Claims 1, 11, 21 and 32 are independent. Claims 2-10, 12-20, 22-31 and 33-38 depend from independent claims 1, 11, 21 and 32, respectively.

By this Amendment, claims 1, 3-6, 8, 11, 13-16, 18, 21-30, 32, and 34-35 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2002/0104099 ("Novak"), in view of USP 6,774,926 ("Ellis"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 103**

The MPEP states the following regarding the requirements for establishing a *prima facie* case of obviousness:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82

USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" See *id.*, § 2143.01. Furthermore, in order to render the claims obvious, the asserted prior art combination must **teach or suggest each and every claim feature**. See *In re Royka*, 490 F.2d 981 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art)<sup>1</sup>; see also *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (A proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art.")

If a *prima facie* case of obviousness is not established, the Applicant has no obligation to submit evidence of nonobviousness:

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<sup>1</sup> Emphasis added except where noted otherwise.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

With these principles in mind, the Applicants now turn to the claim rejections in particular.

**I. THE PROPOSED COMBINATION OF NOVAK AND ELLIS DOES NOT RENDER CLAIMS 1-38 UNPATENTABLE**

**A. Independent Claims 1, 11, 21 and 32**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Novak and Ellis does not disclose or suggest at least the limitation of "determining at a second geographic location, when personal media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic location," as recited by the Applicant in independent claim 1 (emphasis added)

The Final Office Action states the following:

With respect to Claim 1, the claimed "determining when one or both of personal media and/or broadcast media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic location" is met in part by Novak that teaches the determination of scheduled broadcast media by using an electronic program guide, EPG 153, which

is constructed/produced by a local studio 106 or a cable service provider 108 and where personal media can be scheduled by a individual acting as a program director, upload source 122 (Fig. 1; paragraph [0038]). The Novak reference does not explicitly teach that the EPG is scheduled at a given location for presentation at the same location.

However, in the same field of endeavor, Ellis et al. teach a personal television channel system in which contributors such as individuals in the home may create personal television channel programming and may set up scheduling for the personal television channel programming- whereby the contributor and the viewers may use the same user equipment thus enabling a contributor to receive scheduling information of personal and/or traditional television channels (Abstract; Fig. 1; col.1, lines 46-51; col.2, line 65 to col.3, line 6; col.3, lines 18-28; col.4, lines 59-61; col.5, lines 15-22; col.11, lines 45-51; col.14, lines 23-32).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the Novak reference with those of the Ellis et al. reference in order to allow a contributor to receive the personal channel listing that they have contributed. A person of ordinary skill in the art would have been motivated to make such a modification to the Novak reference so as to provide an overall more enjoyable viewing experience by permitting a contributing party to view personal media programming that they are most likely to be interested in.

The claimed "acquiring information related to said scheduled one or both of said personal media and/or said broadcast media from at least one media provider;" is met by Novak that teaches the acquisition of personal media information from an upload source (122,222) pertaining to the scheduling or sequencing of personal media (Figs. 1, 2, 6, & 7; paragraphs [0010], [0039], [0056], [0062], & [0063]). The claimed "and updating, at a second geographic location, said at least one constructed display based on said acquired information" is met by Novak that teaches the updating of an EPG (153) upon acquiring information relevant to the scheduling of the personal media content uploaded by an upload source (122,222) to a local studio (106) or a cable service provider (108) and its subsequent transmittal to a 2nd geographic

location- i.e. a user using set top box 152 (Figs. 1&2; paragraphs [0010], [0041], &[0079]).

See Final Office Action at pages 2-4. The Examiner has equated Applicant's "constructed display" to Novak's electronic program guide 153. Referring to FIG. 1 of Novak, the electronic program guide (EPG) 153 is produced/generated by the local studio 106, the cable service provider 108, or another party. Additionally, the EPG 153 is defined as "*electronic listing of scheduled television programming*", which means that Novak's EPG consists exclusively of broadcast media (i.e., the scheduled television programming), and not personal media. See Novak at paragraphs 0027, 0037. Therefore, **Novak does not disclose any determining at a second geographic location, when personal media is scheduled in at least one constructed display at a first geographic location.**

Additionally, Novak's EPG is stored at the set-top-box (STB) 152 at the cable subscriber's location. See Novak at ¶ 0037. If we assume that the "first geographic location" is where the EPG is scheduled/generated (i.e., the local studio 106 or the cable service provider 108), the Applicant points out that Novak's EPG is for presentation at the cable subscriber's location and not at the location where the EPG was scheduled/generated, i.e., EPG is not for presentation at the "first geographic location." Furthermore, the "first geographic location" cannot be the cable subscriber's location since, as explained in Novak's ¶ 0037, **the EPG is generated outside of the**

**subscriber's location and then it is provided to the subscriber** and stored at the STB 152 for subsequent display. In other words, **Novak does not disclose that the EPG is scheduled at a given location for presentation at the same location.** The Examiner conceded that Novak does not explicitly teach that the EPG is scheduled at a given location for presentation at the same location, and then relied for support in Ellis by stating the following:

However, in the same field of endeavor, Ellis et al. teach a personal television channel system in which contributors such as individuals in the home may create personal television channel programming and may set up scheduling for the personal television channel programming- whereby the contributor and the viewers may use the same user equipment thus enabling a contributor to receive scheduling information of personal and/or traditional television channels (Abstract; Fig. 1; col.1, lines 46-51; col.2, line 65 to col.3, line 6; col.3, lines 18-28; col.4, lines 59-61; col.5, lines 15-22; col.11, lines 45-51; col.14, lines 23-32).

See the Final Office Action at page 3. Ellis discloses, in relevant parts, the following: "An individual at home or at another suitable location may use user equipment 34 to create content for a personal television program or channel" (Col. 3, ll. 19-21); "A contributor may set up a schedule for the personal television channel programming that the contributor has created" (Col. 11, ll. 46-48); and "Viewers may use a program guide or other interactive television application to view program schedule information" (Abstract). Even though Ellis discloses that a contributor may set up a schedule for the personal television channel programming that the contributor has created, Ellis is still

deficient. If the location of Ellis' contributor (i.e., the location where the personal television channel programming is created) is considered to be at a "first geographic location", Ellis does not disclose any determining, at another geographic location (i.e., the "second geographic location"), that personal media is scheduled at the first geographic location. In other words, Ellis still does not overcome the above deficiency of Novak.

In addition, Ellis does not teach or suggest that the EPG is scheduled at a given location for presentation at the same location. In fact, Ellis is very similar to Novak with regard to how the EPG is generated and handled. More specifically, Ellis discloses a system for distributing personal television channel programs and program schedule information (EPG) from contributors to viewers. The program schedule information (e.g., the EPG) is first communicated to a data storage facility (52 in FIG. 1) for storage in the program schedule database (54 in FIG. 1). See Ellis at col. 1, lines 25-45. From the program schedule database, the EPG information is communicated to television distribution facilities (32 in FIG. 1). Only then is the EPG distributed to the individual viewers at the user equipment 34. See *id.* at col. 4, lines 42-58. In this regard, Ellis, similarly to Novak, does not disclose that the EPG is scheduled at a given location for presentation at the same location.

Therefore, the Applicant maintains that the combination of Novak-Ellis does not disclose or suggest at least the limitation of “determining at a second geographic location, when personal media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic location,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of claim 1, the Applicant submits that the combination of Novak and Ellis does not disclose or suggest at least the limitation of “acquiring at said second geographic location, information related to broadcast media from at least one media provider and information related to said personal media, wherein said information related to said broadcast media is associated with a media subscription established at said first geographic location,” as recited by the Applicant in independent claim 1 (emphasis added). As explained above, Novak’s EPG 153 is defined as “*electronic listing of scheduled television programming*”, which means that Novak’s EPG consists exclusively of broadcast media (i.e., the scheduled television programming), and not personal media. In addition, neither the local studio 106 nor the cable provider 108 (which are the entities that generate the EPG 153) acquire both personal media and broadcast media for purposes of updating the EPG (or the constructed display) with both types of media, where the broadcast media is associated



with a media subscription established at the first geographic location. Ellis does not overcome this deficiency of Novak.

Therefore, the Applicant maintains that the combination of Novak-Ellis does not disclose or suggest at least the limitation of “acquiring at said second geographic location, information related to broadcast media from at least one media provider and information related to said personal media, wherein said information related to said broadcast media is associated with a media subscription established at said first geographic location,” as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Novak and Ellis does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11, 21 and 32 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21 and 32 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-10, 12-20, 22-31 and 33-38**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21 and 32 under 35 U.S.C. § 103(a) as being unpatentable

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over Novak in view of Ellis has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, 22-31 and 33-38 depend from independent claims 1, 11, 21 and 32, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, 22-31 and 33-38.

In general, the Final Office Action makes various statements regarding claims 1-38 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

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### **CONCLUSION**

Based on at least the foregoing, Applicant believes that all pending claims 1-38 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 18-APR-2011

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